

REPLY TO OFFICE ACTION OF 6 MAY 2004

SERIAL NO: 09/550,276
DOCKET NO: 010-US-002**REMARKS**

This paper is intended to be a complete response to the above-identified Office Action. It is believed no fee is due. If fees are required, however, the Commissioner is authorized to deduct the necessary charges from Deposit Account 501927/010-US-002.

Claims 1, 10, 11 and 13 have been amended. No claims have been added or cancelled. Accordingly, 27 claims are currently pending in the instant application (claims 1-4, 10, 11, 13-31, 33 and 34).

Section 112 Formalities

The Examiner has rejected claims 1-4, 10, 11, 13-31, 33 and 34 as being indefinite for their use of the phrase "adapted to." (Office Action at pages 3-5.) Without any intent to change, modify or alter the scope of the claimed subject matter, claims 1, 10 and 13 have been amended to substitute a different phraseology as recommended by the Examiner. Claims 2, 11, 13, 23, 26 and 27 continue to incorporate the "adapted to" language. For the reasons set forth in Applicant's Appeal Brief dated 23 January 2004, the retained use of this phrase is believed to be definite to one of ordinary skill in the art and fully supported by established case law.

Applicant notes that the Examiner appears to have dropped her rejection to use of the phrase "cytometric characteristic of a sample" in claims 1 and 10 as no such rejection was expressed in the above-identified Office Action. Applicant further notes that the Examiner appears to have dropped her rejection to dependent claim 3 as being "indefinite in relation to claims 1 and 4" as no such rejection was expressed in the above-identified Office Action. Finally, Applicant notes that the Examiner appears to have dropped her rejection to use of the phrase "analog to digital converter" in claim 25 as no such rejection was expressed in the above-identified Office Action.

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The Examiner has rejected claims 1, 2, 10, 11, 21, 22, 33 and 34 as allegedly being anticipated under 35 U.S.C. 102(b) by U.S. Patent 5,582,795 to Nishina et al. (hereinafter Nishina). Specifically, the Examiner asserts that:

Nishina et al disclose a hold-transfer system or apparatus for use in analyzing fluids such as blood and medicines (see column 1, lines 6-9). The apparatus comprises a rotating means (stepper motor) which receives and rotates transparent cylinders (test tubes) about the longitudinal axis of the transparent cylinder ... The apparatus has a light source such as a laser or light emitting diode (LED) which illuminates a portion of the transparent cylinder (barcode) while the transparent cylinder is being rotated. The apparatus further comprises a detector and determining means (automatic scanning type barcode reader) which detects light signal provided by the light source and reflected from the barcode while the transparent cylinder is being rotated. The barcode reader determines cytometric characteristics of a sample disposed in the transparent cylinder (see column 3, line 45 to column 4, lines 19, and column 5, lines 4-20). The apparatus also includes a movements means (first and second motors) for moving the transparent cylinder, the light source and barcode reader along a longitudinal axis relative to one another (see column 3). (Office Action at page 6.)

Nishina is directed to a "hold-transfer system for extraction of containers ... [and] ... comprises a main body and cassette ... The cassette comprises holding means for holding extraction containers in an upright position, an endless travelling [sic] unit ... [and] a driving rotor and driven rotor ... so that the endless travelling [sic] unit can travel. The main body comprises driving means for the driving rotor and an identifying means for a identifying [sic] mark on the container ... Accordingly, operations such as extraction, identification, and transfer will be done in series and repeatedly as the endless travelling [sic] unit travels." (Nishina at col. 1, line 60 to col. 2, line 9; see also col. 2, lines 10-26.)

As clearly described by Nishina, extraction containers are transported in an "oblong configuration." (Nishina at col. 2, lines 32-38 and FIG. 1.) In accordance with Nishina, extraction containers are affixed to a chain 16 (via metal fittings 17) which is

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rotated along an oblong path by sprockets 14 and 15 in conjunction with motor 27, timing pulleys 24 and 25, timing belt 26 and shafts 22 and 23. (Nishina at col. 3, lines 4-38 and FIG. 1.) Nishina also teaches that this transport may be periodically stopped and an individual extraction container rotated so that bar code reader 33 can read a bar code affixed thereto. (Nishina at col. 5, lines 4-20 and FIG. 2.)

Thus, while Nishina teaches rotating a cylinder about its longitudinal axis, it is simply to permit a bar code affixed to the container to be read. As explicitly recited in independent claims 1 and 10, however, the invention recites "determining at least one cytometric characteristic of a sample *disposed in said transparent cylinder*." Applicant submits that it would be obvious to one of ordinary skill in the art (and, indeed, to a lay person) that reading a bar code *affixed to a transparent cylinder* is **not the same** as determining at least one *cytometric characteristic of a **sample disposed in said transparent cylinder***. That is, the routine action of reading a bar code is in no logical or physical manner connected or related to determining a cytometric characteristic from a sample *inside* a rotating cylinder.

"For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988). Further, the "identical invention must be shown in as complete detail as is contained in the patent claim" (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir.), *cert. denied*, 493 U.S. 853 (1989)) and the "elements must be arranged as in the claim under review" (*In re Bond*, 910 F.2d 831, 832 Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990)). See also M.P.E.P. 2131.

Accordingly, Nishina does not anticipate independent claims 1 and 10 because it does not teach "determining at least one cytometric characteristic of a sample *disposed in said transparent cylinder*." Applicant further submits that determining a cytometric characteristic *from a sample inside a rotating container* is so different an operation from

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reading a bar code affixed to the container, that Nishina can not be said to even suggest the claimed action.

For at least these reasons, the Examiner's rejection of Independent claims 1 and 10 over Nishina is improper. Further, because each of claims 2, 11, 21, 22, 33 and 34 depend from one of Independent claims 1 and 10, these claims too are not anticipated by Nishina. Accordingly, Applicant respectfully requests this rejection be withdrawn and claims 1, 2, 10, 11, 21, 22, 33 and 34 be allowed.

Section 103 Rejections

Applicant acknowledges with appreciation the Examiner's withdrawal of all prior pending section 103 rejections based on the combination of one or more of Cottingham (US 5, 639, 428), Walters (US 6,135,940), Anderson (US 6,254,834), Saralegul (US 5,439,645) and the publication from Surmodics, Inc.

The Examiner has rejected claims 24, 25 and 30 as allegedly being unpatentable under 35 U.S.C. 103(a) over Nishina in view of Milch (US 5,352,879). (Office Action at page 7.) Each of claims 24, 25 and 30 depend from independent claim 10. Because independent claim 10 is allowable over the cited prior art as discussed above, each of dependent claims 24, 25 and 30 is allowable. Accordingly, Applicant respectfully requests this rejection be withdrawn and the claims be allowed.

The Examiner has rejected claim 29 as allegedly being unpatentable under 35 U.S.C. 103(a) over Nishina in view of Izumi (US 5,126,544). (Office Action at pages 7-8.) Claim 29 depends from independent claim 10. Because Independent claim 10 is allowable over the cited prior art as discussed above, dependent claim 29 is allowable. Accordingly, Applicant respectfully requests this rejection be withdrawn and that claim 29 be allowed.

The Examiner has rejected claims 3, 13-18, 26-28 and 31 as allegedly being unpatentable under 35 U.S.C. 103(a) over Nishina in view of Anderson et al. (US 6,254,834). (Office Action at pages 8-9.) Each of claims 3, 13-18, 26-28 and 31 depend

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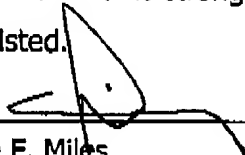
from one of Independent claims 1 and 10. Because Independent claims 1 and 10 are allowable over the cited prior art as discussed above, each of dependent claims 3, 13-18, 26-28 and 31 is allowable. Accordingly, Applicant respectfully requests this rejection be withdrawn and the claims be allowed.

The Examiner has rejected claims 4, 19, 20 and 23 as allegedly being unpatentable under 35 U.S.C. 103(a) over Nishina in view of Anderson et al. (US 6,254,834) and further in view of Surmodics, Inc. (Office Action at pages 9-11.) Each of claims 4, 19, 20 and 23 depend from one of Independent claims 1 and 10. Because independent claims 1 and 10 are allowable over the cited prior art as discussed above, each of dependent claims 4, 19, 20 and 23 is allowable. Accordingly, Applicant respectfully requests this rejection be withdrawn and the claims be allowed.

CONCLUSIONS

Reconsideration of the pending claims 1-4, 10, 11, 13-31, 33 and 34 in light of the above remarks and amendments is respectfully requested. If, after considering this reply, the Examiner believes that a telephone conference would be beneficial towards advancing this case to allowance, the Examiner is strongly encouraged to contact the undersigned attorney at the number listed.

4 AUGUST 2004
Date


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